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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/572,993

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EXAMINER

PEZZUTO, HELEN LEE

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

05/05/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/572,993	Applicant(s) SCHINABECK ET AL.	
	Examiner Helen L. Pezzuto	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-34 is/are pending in the application.
- 4a) Of the above claim(s) 18-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 18-34 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group III, claims 31-34 in the reply filed on 4/3/09 is acknowledged. The traversal is on the ground(s) that it would not be an undue burden for the Examiner to search more than one species of each species category at a time. This is not found persuasive because the search of the copolymer does not require the search for aqueous building materials as set forth in the restriction requirement.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 18-30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 4/3/09.

Currently, claims 31-34 are under consideration, incorporated with the limitations of the copolymer structure as set forth in claim 18.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 31-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Albrecht et al. (US-887).

US 6,187,887 to Albrecht et al. discloses water-soluble or water-swellable copolymer comprising structural units a), b), c), and d) as defined in formula (I), (IIa) and/or (IIb), (III), and (IV), respectively, encompassing the instant a), b), and c) recurring units (col. 2, line 40 to col. 4, line 44; col. 5, lines 9-21). The resultant copolymer has a number average molecular weight of 50,000 to 5,000,000, and is taught to have utilities as additives in aqueous building materials, water-based paints and coating system (see abstract; col. 6, line 66 to col. 7, line 3). US-887 suggests using 0.05-5 wt% of the resultant copolymer based on the dry weight of the construction material, paint or coating system (col. 7, lines 4-9). Prior art further exemplifies using the instant copolymer

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in mortar mix compositions (col. 10, line 10 to col. 13, line 24). Thus, anticipating the present claims.

5. Claims 31-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Schinabeck et al. (US-760)

The applied reference has a common assignee and inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

US 7,238,760 to Schinabeck et al. discloses water-soluble or water-swellaable copolymer comprising structural units a), b), c), and d) as defined in formula (I), (IIa) and/or (IIb), (IIIa), and (IV), respectively, embracing the instant a), b), and c) recurring units (col. 3, line 20 to col. 6, line 30). The resultant copolymer has a number average molecular weight of 50,000 to 20,000,000, and is taught to have utilities as additives in aqueous building materials, water-based paints and coating system (see abstract; col. 6, lines 34-38; col. 8, line 45-49). US-887

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suggests using 0.05-5 wt% of the resultant copolymer based on the dry weight of the construction material, paint or coating system (col. 8, lines 50-53). Prior art further exemplifies using the instant copolymer in a tile-adhesive mortar mix compositions (working Examples; col. 14, line 20 to col. 15, line 45). Thus, anticipating the present claims.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oswald et al. (US-853).

US 6,395,853 to Oswald et al. discloses water-soluble copolymer with utilities as additives in cemented deep well exploration and petroleum or natural gas production.

Specifically prior art teaches a copolymer comprising recurring units a), b), c1), or c2), and may further contain 2-95 wt% of

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formula (5) as defined by formulas (1), (2), (3), (4), and (5) respectively, embracing the instant copolymer containing a), b), and c) recurring units (see abstract; col. 4, lines 56-60). The resultant copolymer has a number average molecular weight ranges from 50,000 to 3,000,000 (col. 6, lines 35-38), and is used in an amount of 0.1-2.0 wt% based on the cement used to cement slurries of conventional composition (col. 9, lines 16-27). Accordingly, it would have been obvious to one having ordinary skill in the art to prepare a water-soluble copolymer comprising the recited monomer units and use the resultant copolymer as additives in cemented deep well exploration and petroleum or natural gas production as taught, motivated by the reasonable expectation of success.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen L. Pezzuto whose telephone number is (571) 272-1108. The examiner can normally be reached on 8 AM to 4 PM, Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Helen L. Pezzuto/
Primary Examiner
Art Unit 1796

hlp